

REMARKS

Claims 1-6 have been rejected under 35 U.S.C. 102 as anticipated by Shinozuka, US 5,190,582. The rejection is respectfully traversed.

Shinozuka relates to an ink-jet printing ink in which a colorant is dispersed in a dispersion medium which is the combination of an organic solvent and a resin soluble in the solvent. See column 5, lines 31-33 and column 6, lines 34-36. While the Office Action avers that there is an energy curable monomer, oligomer or mixture present, citing column 8, lines 50-60, the Examples and Table 2, no such disclosure has been found in the reference. The column 8 passage relates to the use of a dye as a colorant or various binder polymers or waxes. There is nothing in the reference which teaches or suggests that any are energy curable. The examples and Table 2 illustrate various combinations of colorant, organic solvent and a resin soluble in the organic solvent, but include nothing which can be identified as energy curable.

Accordingly, the novelty rejection is untenable and should be withdrawn.

All claims have been rejected under 35 U.S.C. 103 over Laufer in view of Shinozuka. The rejection is respectfully traversed.

Laufer describes a radiation curable ink which contains an acrylic monomer or oligomer, photoreactive resin, photoinitiator, free radical inhibitor and pigment. The photoreactive resin is a reaction product of benzoylbenzoic acid and an epoxidized oil, and is stated to be a unique material at column 7, lines 49-52 and at column 8, lines 16-17. The synthesis of the resin is described in column 8 and the finished resin is indicated to be a hard thermoplastic at column 8, lines 49-50. There is nothing in the reference which

teaches or suggests that this hard thermoplastic is solvent-soluble. The last paragraph on page 4 of the Office Action agrees that there is no disclosure of a solvent-soluble resin in Laufer. The first bullet point on this page is clearly in error since there is no such disclosure at column 7, line 40-45 (which refers to 20-50% of the reaction product of o-benzoylbenzoic acid and an epoxidized oil), or elsewhere in this patent.

The rejection on page 5 avers that Shinozuka teaches use of a solvent-soluble resin to get a blur free, high density printed image. There is no basis for this assertion and it improperly crosses the line at which simplification for description purposes becomes an alteration of the teachings of a reference. *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 220 USPQ 97, 103 (Fed. Cir. 1983). The cited passage, column 9, lines 20-30, has no text from which it could be concluded that use of a solvent-soluble resin results in a blur free, high density printed image in any type of printing. Quite to the contrary, Shinozuka states at column 2, lines 22-29 that control of the colorant particle size and surface tension of the dispersion medium is the reason blur free prints are obtained.

As the rejection implicitly recognized, there must be some reason to extract some teaching from a secondary reference and incorporate it into the primary reference. As just pointed out, the only reason proposed in the Office Action is not correct. In addition, Laufer relates to a decorating ink applied by surface-to-surface transfer contact of a continuous ink layer (e.g., lithography or offset, col. 1, lines 20-22) whereas Shinozuka relates to ink-jet printing where a plurality of droplets of ink are expelled from a printer to the paper being printed. Materials useful in one type of these printing methods are not necessarily useful in the other. Even in the absence of this additional reason, no valid reason for extracting a solvent-soluble resin from Shinozuka (or any other reference) is present and therefore, the combination is improper.

In view of the above remarks, applicant believes the pending application is in condition for allowance.

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